

REMARKS

This is in response to the non-final Office Action mailed September 9, 2008. In the Office Action, the Examiner notes that claims 8-12 and 15-19 are pending and rejected.

In view of the following discussion, Applicants submit that none of the claims now pending in the application are indefinite or obvious under the provisions of 35 U.S.C. §103. Thus, Applicants believe that all of these claims are now in allowable form.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the art of record to the pending claims by filing the instant response.

Rejection of claims 8-21 under 35 U.S.C. §103

The Examiner has rejected claims 8-21 under 35 U.S.C. §103(a) as being unpatentable over Day et al. (U.S. Pat. 5,996,015, hereinafter "Day") in view of Chowdhury et al. (US Pat. 6,026,439, hereinafter "Chowdhury"), DeMoney (U.S. Patent 6,065,050, hereinafter "DeMoney") and Katinsky et al. (U.S. Pat. 6,452,609, hereinafter "Katinsky"). Applicants respectfully disagree.

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to

support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (Fed.Cir. 2006), *cited with approval by KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); *see also* MPEP §2141.

The Applicants incorporate herein by reference the 37 CFR §1.114 submission of August 20, 2008. In addition, Applicants respectfully note that the rejection is defective for the reasons set forth below.

First, Applicants respectfully note that the Examiner has failed to provide the motivation upon which the Examiner relies in rejecting Applicants' claim 8. To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. See MPEP §2143. More specifically, on page 5 of the Office Action the Examiner provided motivation to implement Chowdhury's teachings in the system of Day. However, the rejection is based on Day in view of Chowdhury further in view of DeMoney and further in view Katinsky. The combination Day and Chowdhury failed to teach every element of the claim. To cure the deficiencies of this first combination DeMoney had to further modify the first combination. This second combination also failed to fill the substantial gap left by the combination of these three references. The Examiner had to summon a fourth reference to produce a third combination. Accordingly, each combination requires its own motivation. Therefore, motivation is required to combine Chowdhury and Day with DeMoney. In addition, motivation is further required to combine Chowdhury, Day and DeMoney with Katinsky. Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness under 35 U.S.C. §103(a). Accordingly, Applicants respectfully submit that the rejection should be withdrawn.

Second, Applicants respectfully submit that Day, Chowdhury, DeMoney and Katinsky, alone or in any permissible combination, fail to teach or suggest all claim limitations, and, thus, fail to teach or suggest Applicants' claim 8, as a whole. See MPEP §2143.03. Specifically, each of Day, DeMoney, and Katinsky fails to teach or suggest the limitations of "said server controller, in response to a remaining portion of a current content stream being provided to said subscriber equipment being below a threshold, communicating a termination notification to said session manager" and "said session manager, in response to said termination notification, communicating

to said server controller an indication of a next content stream to be provided to said subscriber equipment,” any permissible combination of Day, DeMoney, and Katinsky (assuming such combination is even possible) also fails to teach or suggest the limitations of “said server controller, in response to a remaining portion of a current content stream being provided to said subscriber equipment being below a threshold, communicating a termination notification to said session manager” and “said session manager, in response to said termination notification, communicating to said server controller an indication of a next content stream to be provided to said subscriber equipment,” as claimed in Applicants’ claim 8. Applicants respectfully submit that after reviewing the references, Applicants could not discern any reference that fairly suggests the above recitations. It appears the Examiner does not accord any patentable weight to certain phrases (e.g., equipment being below a threshold) within the context of the claims. All words in a claim must be considered in judging the patentability of that claim against the prior art. See MPEP §2143.03. One cannot divine claim meaning in a vacuum. *Philips v. AWH Corporation* (Fed. Cir. July 12, 2005).

Furthermore, on page 3 of the Office Action, the Examiner states: “The session manager further inherently ‘stores’ (by caching) the generated playlist at the server while the session is alive, in order to access the playlist for playback of next media clip.” Moreover, it is respectfully submitted that before a reference can be found to disclose a feature by virtue of inherency, one of ordinary skill in the art viewing the reference must understand that the unmentioned feature at issue is *necessarily* present in the reference. *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991) The test of inherency is not satisfied by what a reference “may” teach. *Id.* (“Inherency... may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient”.)

Accordingly, as Day alone or combined with Chowdhury, DeMoney and Katinsky does not teach or suggest each and every limitation of Claim 8, it is respectfully requested that the rejection of Claim 8 under 35 U.S.C. §103 be withdrawn.

Thus, for at least the above reasons, Applicants respectfully submit that independent claim 8 is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder. Similarly, Applicants’ independent claim 16 includes limitations similar to the

limitations of Applicants' independent claim 8 and, thus, at least for the same reasons discussed herein with respect to claim 8, Applicants respectfully submit that independent claim 16 also is not obvious and fully satisfies the requirements of 35 U.S.C. §103 and is patentable thereunder.

As such, Applicants respectfully submit that independent claims 8 and 16 are not obvious and fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder. Furthermore, claims 9-12, 15 and 17-19 depend, either directly or indirectly, from independent claims 8 and 16 and recite additional features thereof. As such, and at least for the same reasons as discussed above, Applicants submit that these dependent claims also fully satisfy the requirements of 35 U.S.C. §103 and are patentable thereunder.

Therefore, Applicants respectfully request that the rejections be withdrawn.

Regarding the rejection of claim 16, the Examiner failed to articulate any motivation whatsoever for combining the references. The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. "To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). See MPEP § 2144- § 2144.09 for examples of reasoning supporting obviousness rejections. In this case, the Examiner did not provide any line of reasoning at all, let alone a convincing argument. Therefore, the Examiner is respectfully requested to provide a new non-Final Office Action properly articulating a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

CONCLUSION

As such, Applicants submit that claims 8-12 and 15-19 are in condition for allowance. Accordingly, both reconsideration of this application and its swift passage to issue are earnestly solicited.

If, however, the Examiner believes that there are any unresolved issues requiring adverse final action in any of the claims now pending in the application, it is requested that the Examiner telephone Michael Bentley at (732) 383-1434 or Eamon J. Wall at (732) 383-1438 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: _____

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